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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/777,336 12/27/96 HOLMES

D 7-2

EXAMINER

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MIDDLETOWN NJ 07748

LM61/0608

ART UNIT	GELIN, J PAPER NUMBER
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2744
DATE MAILED:

5
06/08/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/777,336

Applicant(s)

David W.J. Holmes

Examiner

Jean A. Gelin

Group Art Unit

2744



☒ Responsive to communication(s) filed on Dec 27, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3, 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding to claims 3 and 9, the phrase "paging network" renders the claims vague and indefinite, since the phrase is not in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the phrase "upon receipt of a communication request on said voice network accesses the stored address information for the mobile station and notifies the mobile station of receipt of said communication request" is unclear.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 are rejected under 35 U.S.C. 102^e(~~1~~) as being anticipated by Pepe et al. (Pepe).

Regarding to claim 1, Pepe teaches in a communication system comprising a first network and a second network wherein a mobile station is capable of being coupled to either one of the first and second networks, a method for notifying the mobile station of a communication on a network to which the station is not presently coupled, the method comprising the steps of: storing an address for the mobile station as it is coupled to one of said first and second networks (col. 6, line 20 to col. 7); receiving a communication request from that one of said first and second networks to which the mobile station is not presently coupled (col. 7, line 39 to col. 8); using the

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stored address of the mobile station as it is coupled to one of said first and second networks to send an alert that said communication request has been received (i.e., inherent in col. 10, line 34 to col. 11, line 64).

“With respect to claims 12-13, they have limitations similar to those discussed above, and hence are rejected as being anticipated by Pepe et al. for the same reason given above.”

Regarding to claim 2, Pepe teaches the steps of: detecting when the mobile station changes the network to which it is coupled (col. 11, line 33 to col. 12); and updating a memory with an address of the mobile station in the network to which it is coupled (col. 7, lines 4-20).

Regarding to claims 3, 9, Pepe further teaches said first network is a voice network and said second network is a paging network (col. 26, lines 14-65).

Regarding to claim 4, Pepe further teaches said first network is a voice network (i.e., voice communication) and said second network is a data network (col. 25, line 9 to col. 26).

Regarding to claim 5, Pepe inherently teaches the mobile station is initially coupled to said first network, said step of storing occurs after the mobile station changes its coupling to the second network, and said step of receiving receives a communication request from said first network (col. 21, line 16 to col. 22).

Regarding to claim 6, Pepe inherently teaches the step of receiving receives a communication request from said second network (cols. 29-32).

Regarding to claim 7, Pepe inherently teaches that the mobile station is initially coupled to said second network, said step of storing occurs after the mobile station changes its coupling to

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said first network, and said step of receiving receives a communication request from said first network (col. 21, line 16 to col. 22).

Regarding to claim 8, Pepe inherently teaches said data network is a packet data network (col. 8, lines 49-50).

Regarding to claim 10, Pepe further teaches said alert includes information regarding said received communication request (col. 29, lines 42-64).

Regarding to claim 11, Pepe further teaches said information includes how the mobile station should connect to the communication (col. 29, line 42 to col. 30, line 27).

Regarding to claim 14, Pepe inherently teaches a communication system for permitting communication requests to follow a mobile station after it changes networks, the system comprising: memory storing an address of a mobile station on a network to which it is coupled (i.e., a database; col. 6, lines 20-59); a communication receiver that receives a communications request on a network to which the mobile station is not coupled (i.e., inherent in the system to receive command); and a processor, coupled to said memory and said communication receiver and using said address of the mobile station to alert the mobile station that said communication request was received (col. 8, line 54 to col. 9).

Regarding to claim 15, Pepe teaches the mobile station coupled to a voice network and then changes to a data network, said communication request being received by said voice network (cols. 23-26).

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Regarding to claim 16, Pepe teaches the mobile station is coupled to a data network and then changes to a voice network, said communication request being received by said data network (cols. 23-26).

8. Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jayapalan.

Regarding to claim 17, Jayapalan teaches a wireless communication system for forwarding communication requests across networks comprising (fig. 2): a voice network including a mobile switching center (i.e., item 42 coupled to item 32 via 35); a data network (item 38) including a mobile data intermediate system (item 36); a memory coupled to said voice network and said data work and storing address information for the mobile station as it is camped on said data network (i.e., inherent in col. 3, line 61 to col. 4).

Regarding to claim 18, Jayapalan teaches a processor coupled to said voice network and said memory that, upon receipt of a communication request on said voice network accesses the stored address information for the mobile station and notifies the mobile station of receipt of said communication request (col. 5, line 25 to col. 7).

Regarding to claim 19, Jayapalan teaches that notification of the mobile station of receipt of said communication request includes information regarding the communication (col. 7, line 11 to col. 8, line 12).

Regarding to claim 20, Jayapalan teaches said information includes how the mobile station should connect to the communication (col. 7, line 62 to col. 8, line 22).

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gardner teaches cellular digital packet data mobile data base station.

Roach, Jr. et al. teaches methods and apparatus for communicating data via a cellular network control channel.

Bayley et al. teaches method of invoking and cancelling voice or data service from a mobile unit.

Kamm et al. teaches data gateway for mobile data radio terminals in a data communication network.

Sharman teaches connection of mobile devices to heterogeneous networks.

Slekys et al. discloses cellular data overlay system for storing data identifying selected data allocated channels.

Pepe et al. teaches personal communication internetworking.

Kubler et al. teaches hierarchical data collection network supporting packetized voice communications among wireless terminals and telephone.

Yamada et al. teaches method for automatic mode selection for a dual-mode telephone handset for use in a cellular mobile telephone system and a wireless telephone system.

Davis teaches selective call signaling system with combined wide area paging and high data rate transmissions via radio telephone transceiver.

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Conclusion

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label

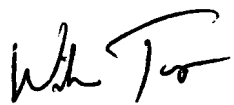
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (703) 305-4847.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Gelin
May 28, 1998


William Trost
Patent Examiner
Group 2700